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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/683,878	10/10/2003	Duane R. Pillar	061300-0361	7841
26371 7590 07/26/2007 FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306			EXAMINER BROADHEAD, BRIAN J	
			ART UNIT 3661	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/683,878	Applicant(s) PILLAR ET AL.	
	Examiner Brian J. Broadhead	Art Unit 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-23, 25, 26 and 28-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-23, 25, 26 and 28-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3-7-07, 4-12-07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1-22-07 has been entered.

Claim Objections

2. Claim 17 is objected to because of the following informalities: In line 23, the claim recites "a plurality of vehicle", is this one of the fleet of equipment service vehicle? It appears to be and has been assumed as such, but the claim should be clarified. Appropriate correction is required.

Claim Rejections - 35 USC § 112

1. Claims 1-13, 32, 33, 23, 25, 26, 28, 29, 30, 31, 35, and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite the limitation of the test program sequentially actuating the plurality of output devised as the PDA moves around the vehicle and manipulates the plurality of outputs devices as the PDA moves around the vehicle and is positioned

adjacent to the at least one of the output devices. The specification does not disclose the requirement that the handheld needs to be in proximity to the output devices and is totally silent as to how it would be determined if the handheld is in proximity to the output device or where the PDA is located as it moves around the vehicle. The specification discloses that there is a test program that runs some outputs sequentially and that an operator can walk around as it operates. There is no disclosure of position detection or the test program operating based on the PDA position. All the specification discloses is that the test program can operate and the user of the PDA can walk around the vehicle if he/she wants to. There is no disclosure of an interaction of the PDA with the test program based on PDA location. The claims as written require the test program to operate based on a position of the PDA. This is not supported in the original specification.

2. Claims 1-13, 32, 33, 23, 25, 26, 28, 29, 30, 31, 35, and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite the limitation of the test program sequentially actuating the plurality of output devices as the PDA moves around the vehicle and manipulates the plurality of outputs devices as the PDA moves around the vehicle and is positioned adjacent to the at least one of the output devices. The specification does not disclose the requirement that the handheld needs to be in proximity to the output devices and is totally silent as to how it would be determined if

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the handheld is in proximity to the output device or where the PDA is located as it moves around the vehicle. The specification discloses that there is a test program that runs some outputs sequentially and that an operator can walk around as it operates. There is no disclosure of position detection or the test program operating based on the PDA position. All the specification discloses is that the test program can operate and the user of the PDA can walk around the vehicle if he/she wants to. There is no disclosure of an interaction of the PDA with the test program based on PDA location. The claims as written require the test program to operate based on a position of the PDA. This is not supported in the original specification.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 14,15, 17-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempen et al., 6421593, in view of Seibel, 20040203974, and further in view of Kaman, 5844473.

3. Kempen et al. clearly discloses all the limitations except for the computer being a PDA; the communications is wireless; and the PDA wirelessly initiates at least a vehicle test program for a plurality of vehicles that manipulates at least one of the plurality of

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output devices. The manipulation of the input and output devices admitted in Kempen et al. reads on the test program.

4. Seibel teaches using a PDA in place of a computer or laptop and using wireless communications in paragraph 11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the PDA in place of the laptop because it is a design choice. The advantages and limitations of a PDA over a laptop or PC are readily evident in the art.

5. Kempen et al. and Seibel disclose the limitations as set forth above. They do not disclose the PDA can be connected to a fleet of vehicles; the PDA wirelessly initiates at least a vehicle test program for a plurality of vehicles that manipulates at least one of the plurality of output devices; and all the various report types. Kaman teaches connecting to a fleet of vehicle to generate reports on lines 63-67, on column 2, and lines 1-5, on column 3; and the PDA wirelessly initiates at least a vehicle test program for a plurality of vehicles that manipulates at least one of the plurality of output devices on lines 15-25, on column 4, the test program can be broadly interpreted as the request for maintenance information. All of the various maintenance and usage reports are a design choice within the ordinary skill of one in the art and provide no unexpected results. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Kaman in the invention of Siebel and Kempen et al. because such modification would provide reliable monitoring of vehicle usage and as Kaman discloses on lines 10-14, on column 1, "the need to collect operational information on mobile vehicles is well known. Recommended vehicular

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maintenance procedures are typically tied to vehicular usage. The more a vehicle is used the more frequently the vehicle must be serviced.”

6. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kempen et al., 6421593, in view of Seibel, 20040203974, in view of Kaman, 5844473, as applied to claims 14, 15, 17-22 above, in view of Lastinger et al., 2005/0060246.

7. Kempen et al., Seibel, and Kaman disclose the limitations as set forth above. They do not disclose the PDA is configured to receive a radio frequency signal from the cargo stored in the storage compartment that includes characteristics of the cargo; and generating a report based on the characteristics of the cargo; and generating a report that incorporates the results of the vehicle test program with the characteristics of the cargo, and the customized report of claim 42. Lastinger et al. teach of a portable reader for receiving radio signals from the cargo including characteristics and generating a report based on the signals in paragraphs 28, 38, 47, 48, 68 and 71-73. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the invention of Lastinger et al. in the invention of Kempen et al., Seibel, and Kaman because such modification would allow the PDA of Kempen et al., Seibel, and Kaman to perform more diagnostics. Lastinger provides a way to gain more operational data such as weight distribution to make sure the vehicle is performing efficiently. The generation of a specific report based upon available information is well within the ordinary skill in the art at the time the invention was made. The choice of the report form would depend on what business the invention was being used for and would be well within routine skill in the art.

8. Claims 37-40, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempen et al., 6421593, in view of Seibel, 20040203974, in view of Kaman, 5844473, in view of Lastinger et al., 2005/0060246, as applied to claim 41 above, and further in view of DeWilde, 2004/0069850.

9. Kempen et al., Seibel, Kaman, and Lastinger et al. disclose the limitations as set forth above. They do not disclose receiving information regarding the destination of the cargo. DeWilde teach storing cargo destination information in the vehicle in paragraphs 9-10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of DeWilde with the previous invention because such modification would ensure prompt and accurate delivery of packages as disclosed by DeWilde. The previous invention is for a vehicle monitoring system, by combining the vehicle monitoring with the package control tracking a delivery fleet operator would have more information available to track operations. In other words, it is within routine skill in the art to combine known data points (ones that are already known to be collected and stored) to an existing system and to produce reports based on this data.

10. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kempen et al., 6421593, in view of Seibel, 20040203974, Kaman, 5844473, as applied to claims 14,15, and 17-22 above, and further in view of Rothert et al., 6141610.

11. Kempen et al., Seibel, and Kamen disclose the limitations as set forth above. They do not disclose generating a customer invoice based on I/O status information. Rothert et al. teach generating a customer invoice based on I/O status information in

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figure 6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Rothert in the invention of Kempen et al., Seibel, and Kamen because such modification would provide for automated billing for a rental fleet without entering information manually as disclosed on lines 37-55, on column 2, of Rothert et al.

Response to Arguments

12. Applicant's arguments filed 4-12-07 have been fully considered but they are not persuasive.

13. With respect to the 35 USC 112 rejections, the arguments do not overcome the lack of disclosure as discussed above. Initiating a test program and then walking around a vehicle while it runs is different than a test program that operates based on where the PDA is located. Operating based on the PDA location is not disclosed and would require some type of relative position location to operate.

14. As per the argument with respect to independent claims 14-18, and 37, the limitation "wherein the PDA device wirelessly initiates at least a test program for each vehicle" is taught in combination by Kempen which teaches running test programs (manipulating a single output device can be interpreted as a test program under the broadest reasonable interpretation), Siebel discloses the wireless communications, and Kaman teaches the ability to connect to a fleet of vehicles with the PDA. The limitation "that manipulates at least one of the plurality of output devices" is admitted art in Kempen. The limitation of "the PDA generates a report that compares the vehicle test program manipulation" is disclosed as a design choice of the reports disclosed by

Kaman. Varying reports based on available information only requires routine skill in the art.

15. Beginning on page 24, Applicant argues the cited references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

16. Applicant's arguments with respect to claim 37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Broadhead whose telephone number is 571-272-6957. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 571-272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brian J. Broadhead
Examiner
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